

## **REMARKS**

Applicants have timely submitted this response to the Examiner's Final Office Action of March 8, 2005. The Final Office Action has been carefully reviewed and the following remarks are made in response thereto. In view of the following remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

### **I. Summary of the Office Action**

1. Claims 1-24 are currently pending.
2. Claims 1-24 were rejected under 35 U.S.C. § 103(a) as purportedly obvious over Webfeat and Hoyt *et al.* and Msdn.
3. No claims were allowed.
4. This Action was made FINAL.

### **II. Response to the Office Action**

#### **1. Rejection of the claims under 35 U.S.C. § 103(a) as purportedly obvious over Webfeat and Hoyt *et al.* and Msdn.**

Claims 1-24 were rejected under 35 U.S.C. § 103(a) as purportedly obvious over Webfeat and Hoyt *et al.* and Msdn. Applicants respectfully traverse this rejection.

The Examiner has not established a *prima facie* case of obviousness for three reasons. First, the Examiner relies on two references - Webfeat and Msdn – that do not qualify as prior art. Second, neither Webfeat, Msdn nor Hoyt *et al.* disclose or suggest, either alone or in combination, each and every element of the claimed methods and systems. Third, there is no motivation to modify or combine the cited references.

#### **A. The cited references - Webfeat and Msdn – do not qualify as prior art.**

##### **i. Webfeat**

Applicants respectfully traverse the availability of Webfeat as a competent reference, because the reference provides no specific teaching of the Webfeat system prior to the filing date of this application. In an attempt to establish the reference as prior

art, the Examiner relies on a statement in a separate article located at <http://www.libraryjournal.com/index.asp?layout=articlePrint&articlID=CA200892> to date the Webfeat knowledge prism to 1998 (*See*, Office Action paragraph 5, page 2). However, nothing on the Library Journal webpage identifies either what occurred in 1998 or identifies the date the Webfeat system was either invented, published, or otherwise made available to the public. The Examiner appears to rely on a statement in the first paragraph of the article found on the Library Journal webpage where the founder of Webfeat states that he came up with an idea in 1998 for what later became the Webfeat system. There is, however, no connection between that general statement and the description of Webfeat relied upon by the Examiner located at <http://www.webfeat.org/prism.html>. There is no indication, suggestion or means to verify that the 1998 “idea” is identical, similar or how it varies from the system described in the cited and undated reference. Although the Webfeat webpage purports to describe the Webfeat system, there is no date on the reference. Importantly, “[p]rior art disclosures on the Internet or on an online database are considered to be publicly available as of the date the item was publicly posted. If the publication does not include a publication date (or retrieval date)<sup>1</sup>, it cannot be relied upon as prior art under 35 U.S.C. 102(a) or (b)...” MPEP §2128.01 (8<sup>th</sup> Ed. Inc. Rev. No. 2). The Webfeat reference does not include a publication date, and thus “cannot be relied upon as prior art under 35 U.S.C. 102(a) or (b).” *Id.*

By failing to establish the date of publication of the Webfeat reference, the Examiner has failed to establish Webfeat as prior art to the claimed invention under any section of 35 U.S.C. § 102. Because the Examiner relied on the Webfeat reference to reject claims 1-24, and because the Examiner has not established that the Webfeat reference is prior art, the Examiner has thus failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a). Applicants therefore respectfully request that this rejection of claims 1-24 be withdrawn, and that the pending claims be allowed.

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<sup>1</sup> The retrieval date of both the Webfeat reference and the Library Journal article is June 13, 2004 – well after the filing date of this application.

**ii. Msdn**

Similarly, Applicants respectfully traverse the availability of Msdn as prior art because its publication date is unknown. This reference provides absolutely no indication of when the Msdn system or services were invented, published, or otherwise made available to the public. In fact, the reference states that the webpage was last updated in May 2004 – after the filing date of this application. The Examiner asserts that some references do not need dates. (Telephonic Interview with Jennifer Overly, April 28, 2005). Applicants respectfully disagree.

“Prior art disclosures on the Internet or on an online database are considered to be publicly available as of the date the item was publicly posted. If the publication does not include a publication date (or retrieval date)<sup>2</sup>, it cannot be relied upon as prior art under 35 U.S.C. 102(a) or (b)...” MPEP §2128.01 (8<sup>th</sup> Ed. Inc. Rev. No. 2). The Msdn reference has no date, and thus “cannot be relied upon as prior art under 35 U.S.C. 102(a) or (b).” *Id.*

By failing to establish the date of publication of the Msdn reference, the Examiner has failed to establish Msdn as prior art to this application under any section of 35 U.S.C. § 102. Because the Examiner relied on the Msdn reference to reject claims 1 – 24, and because the Examiner has not established that the Msdn reference is prior art, the Examiner has thus failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a). Applicants therefore respectfully request that this rejection of claims 1-24 be withdrawn, and that the pending claims be allowed.

**B. Each and every element of the claimed invention is not disclosed or suggested by the cited references.**

**i. Msdn**

The Webfeat reference does not disclose or suggest each and every element of the claimed methods and systems. The Examiner acknowledges that Webfeat is “not explicit regarding ‘interactive’ – especially in relation to graphical user interfaces, GUI’s.” (See,

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<sup>2</sup> The retrieval date of the Msdn reference is June 13, 2004 – well after the filing date of this application.

Office Action paragraph 1, page 5). Instead, the Examiner alleges that Msdn “directly mentions and discusses the interactive nature.” (See, Office Action paragraph 2, page 2). However, the Examiner further fails to consider the reference as a whole, by ignoring the limitation of the reference that only one window station can be interactive. The claimed methods and systems, on the other hand, are not limited. Consequently, the Applicants respectfully traverse the Examiner’s finding that Msdn teaches this element, as it, in fact, teaches away from this element. Accordingly, Applicants respectfully request withdrawal of the Examiner’s rejection of claims 1-24 and allowance of the pending claims.

**ii. Hoyt *et al.***

The Examiner has not established a *prima facie* case of obviousness for claims 1-24, because 1) the cited references do not predate the instant application; 2) the cited references do not teach each element of the claimed invention; and 3) there is no motivation to combine the cited references. The Examiner’s reliance on Hoyt *et al.* does not cure these deficiencies.

Hoyt *et al.* does not disclose or suggest an interactive library system comprising a user computer, a library system computer, and a content provider computer. Furthermore, Hoyt *et al.* does not disclose or suggest interaction between the user computer and the library system computer; the library system computer and the user computer; the library system computer and the content provider computer; and the content provider computer and the library system computer. Accordingly, Applicants respectfully request withdrawal of this rejection and claims 1-24 be allowed.

**C. The Examiner ignores elements of dependent claims 3-17 and 19-24.**

In the October 1, 2004 Response to the July 1, 2004 Office Action, Applicants explained the deficiencies in the Examiner’s rejection. Namely, that the Examiner issued a blanket rejection of dependent claims 3-17 and 19-24 as purportedly obvious over knowledge in the art. The Examiner relies on no reference. The Examiner has not yet

addressed Applicants' arguments with respect to these claims. These arguments are set out below, and consideration and responses thereto are respectfully requested.

**i. Insufficient *prima facie* case of obviousness.**

As explained above, the Examiner's rejection of independent claims 1 and 18 is insufficient to support a *prima facie* case of obviousness under 35 U.S.C. § 103(a). Consequently, the Examiner's rejection of these independent claims fails as a matter of law.

**ii. Improper reliance on knowledge in the art.**

The Examiner's reliance on official notice to establish substantive, non-trivial facts that are incapable of unquestionable demonstration of being well known ignores the recited limitations of the dependent claims and is improper.

With respect to claims 3, 6-11, and 19-24, the Examiner takes official notice of the state of the art and states "such account and access handlings was well known in the art for the motivation of accuracy of billing and security." With respect to claims 4 and 5, the Examiner takes official notice of the state of the art and states "such access restriction to Deal Room was well known in the art for the motivation of security." With respect to claims 12-17, the Examiner takes official notice of the state of the art and states "such handlings of usage was well known in the art for the motivation of accuracy of billing and security." Applicants respectfully disagree.

Reliance on official notice is permissible under only very limited circumstances. Official notice without documentary evidence to support an examiner's conclusion should be taken only on the rare occasion when the noticed fact is capable of instant and unquestionable demonstration as being well known. (*See*, MPEP § 2144.03; *see also*, *In re Ahlert*, 424 F.2d 1088, 1091 (CCPA 1970)). That is not the case here.

Applicants respectfully note that broad notice that, for example, "such account and access handlings was well known in the art for the motivation of security", does not take into account the specific methods recited by the claims. Moreover, by taking official

notice of “account and access handlings”, the Examiner ignores recited elements of the claims. These elements are not disclosed or suggested by any reference cited by the Examiner, and the fact is not of the type for which official notice is appropriate. Applicants therefore respectfully request that the rejection of claims 3-17 and 19-24 be withdrawn, and that the Examiner allow all pending claims.

### **III. Conclusion**

Applicants believe that the above-referenced application is in condition for allowance. Reconsideration and withdrawal of the outstanding rejections and early notice of allowance to that effect is respectfully requested.

**EXCEPT** for issue fees payable under 37 C.F.R. § 1.18, the Director is hereby authorized by this paper to charge any additional fees during the entire pendency of this application, including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 13-3250, reference No. 02012.04121. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

If the Examiner finds that a telephone conference would further prosecution of this application, the Examiner is invited to contact the undersigned at 202-835-7512.

Respectfully submitted,

**MILBANK, TWEED, HADLEY & MCCLOY LLP**

Dated: May 18, 2005

  
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